

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed June 25, 2004. Upon entry of the amendments in this response, claims 25, 33, 36 - 42, 44, 48-51, 55-57 and 68-70 remain pending in the present application. More specifically, claims 44, 48, 55 and 70 are currently amended. Reconsideration and allowance of the application and presently pending claims, as amended, are respectfully requested.

Double Patenting

The Office Action states as follows:

Applicant is advised that should claims 16, 49-51 and 69 be found allowable, claims 44, 55-57 and 70 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

In comparison, the body of two independent claims 36 are identical except slight difference in wording in preamble recitations, *i.e.*, the preamble in claim 36 is "A method for forming an ohmic contact on a compound semiconductor layer of a semiconductor device comprising", whereas the preamble in claim 44 is "An ohmic contact to a compound semiconductor layer of a semiconductor device made by a method."

Although it is noted that claim 44 is a product-by-process claim, product-by-process claims are directed to the product no matter how actually made. In *re Taylor*, 149 USPQ 615, 617 (CCPA 1966). Consequently, it is the patentability of the final product, and not the patentability of the process, that must be determined in a product-by-process claim. In *re Thorpe*, 227 USPQ 964, 966 (CAFC 1985), *Ex parte Edwards* 231 USPQ 981, 983 (BdPatApp&Int 1986). Since preamble language in claim 44 does not constitute a structural limitation of the "ohmic contact", thus the preamble does not limit the claim and is of no significance to claim construction. See M.P.E.P. 2111.02. For the aforementioned reasons, claim 44 is treated as a substantially identical claim to claim 36

Office Action at 2-3 (emphasis omitted). Applicants respectfully traverse.

Because product-by-process claims are directed to the product no matter how it is actually made, and because patentability of the final product and not patentability of the process is determined in a product-by-process claim, Applicants submit that a method claim and a product-by-process claim will therefore *not* be substantial duplicates of each other. The preamble of claim 44, by reciting a product-by-process, *per se* renders claim 44 different in scope from the method claim of 36.

Nevertheless to advance prosecution and facilitate allowance of the claims, Applicants have amended claim 44 to recite specific structural features that render claim 44 different in scope from claim 36. Additionally, claims 48, 55-57, and 70 were objected to as being dependent upon an objected base claim, but were indicated to be allowable if rewritten in independent form. Prior to the amendments submitted in this Response, Applicants have incorporated the subject matter of claim 44 into its dependent claims. Thus, Applicants respectfully submit that any objections under 37 C.F.R. 1.75 have been obviated. Applicants request that claims 44, 55-57, and 70 therefore be allowed.

Indication of Allowable Subject Matter

Applicants first wish to express appreciation for the Examiner's indication of allowable subject matter in which claims 25, 33, 36-42, 49-51, 68, and 69 are deemed allowed.

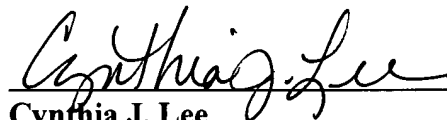
Claim 44 has been objected to under 37 C.F.R. 1.75, as noted above, but would be allowable if rewritten to overcome the objection. As discussed above, claim 44 has been rewritten to overcome this objection.

Claims 42, 55-57, and 70 have been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have rewritten claims 48, 55, and 70 in independent form to incorporate the features of claim 44 into each of claims 48, 55, and 70. Claims 56 and 57 depend from claim 55, and therefore have not been rewritten. Applicants therefore respectfully request that claims 44, 48, 55-57, and 70 be allowed.

CONCLUSION


In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed and/or accommodated, and that the now pending claims 25, 33, 36 - 42, 44, 48-51, 55-57 and 68-70 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, September 21, 2004.


Signature: Gloria Simmons